REMARKS

Reconsideration and allowance in view of the foregoing amendments and the following remarks are respectfully requested.

Upon entry of this Amendment, claims 1-58 remain pending in the present application. Claims 20-58 have been withdrawn from consideration.

A. Restriction Requirement

The Examiner indicates that the present application contains four distinct inventions and listed the claims for each group on page 2 of the Office Action. Applicant hereby affirms the election of the invention of Group I, claims 1-19, for prosecution in the present application. Thus, claims 20-58 have been withdrawn from consideration. Applicant reserves the right to file Divisional applications directed to the inventions defined in claims 20-58.

B. Information Disclosure Statement

An Information Disclosure Statement (IDS) was submitted by the applicant on October 4, 2001. According to the Examiner, a copy of the IDS is missing from the file. As requested by the Examiner, a copy of this IDS is enclosed. Also enclosed is a copy of the PTO-1449 forms accompanying this IDS.

C. Interpretation of the Claims Under 35 U.S.C. § 112, ¶6

On page 4 of the June 18, 2003 Office Action the Examiner indicates that the claims are ***not*** being interpreted under 35 U.S.C. § 112, ¶6, even though the claims use the phrase "means for". The Examiner suggests that if the claims are to be interpreted under 35 U.S.C. § 112, ¶6, the applicant should expressly state this desire on the record.

Applicant respectfully submits that requiring the applicant to expressly state when a claim limitation is to be interpreted under 35 U.S.C. § 112, ¶6 is imposing a burden on the applicant that is not required under current US patent law. M.P.E.P. § 2181 sets for the criteria by which a claim limitation is to be analyzed to determine whether it is a 35 U.S.C. § 112, ¶6 limitation. Short of there being some ambiguity as to whether a limitation is intended to be a

means-plus-function limitation, there is no need or requirement that the applicant expressly state up front whether or not a limitation is intended to invoke an interpretation under 35 U.S.C. § 112, ¶6.

Be that as it may, applicant states, for the record, that any claim limitation using the phrase "means for" is intended to invoke an interpretation under 35 U.S.C. § 112, ¶6, per the claim construction guidelines set forth in M.P.E.P. § 2181. Thus, for example, the limitations in claim 1 that begin, "means for selectively establishing..." are intended to be interpreted as mean-plus-function limitations, while the limitation that begins, "an information management center..." and "a hand-held patient appliance..." are not. Applicant submits that the Examiner, in construing the claims as not being mean-plus-function limitations, has apparently ignored the guidelines set forth in M.P.E.P. § 2181.

D. Lexicography

The Examiner indicates that if the applicant wishes to use lexicography such that a claim limitation has a meaning other than its ordinary and accustom meaning, the claim limitation at issue should be expressly indicated, and the specification or prosecution history showing that meaning should be identified, otherwise any interpretation other than the ordinary meaning will be forfeited. Applicant respectfully submits that the Examiner is again imposing a burden on the applicant that is not required under current US patent law.

The case-law cited by the Examiner states the conditions under which a patentee may attempt to give a limitation a meaning other than its ordinary meaning, i.e., to be his or her own lexicographer. However, that case-law does not require an applicant to expressly state during the prosecution of an application which, if any, claim terms are to have a meaning other than its ordinary meaning. Moreover, the Examiner's indication, that the applicant will forfeit the ability to be his or her own lexicographer unless the applicant states in response to the June 18, 2003 Office Action the meaning of any term not intended to have an ordinary meaning, is preposterous.

Claim interpretation is an issue of special importance typically after a patent has been granted, when an accused infringing device is being compared to the claims in the issued

patent. To require an applicant to expressly state, during the prosecution of the patent application, whether a limitation or term is to have a meaning other than its ordinary and accustom meaning, and to indicate what that meaning is, requires the applicant to predict the future. Under the Examiner's claim interpretation conditions, an applicant must predict what interpretation a future infringer may try to impose on a term, and to nullify that interpretation by expressly stating here and now what the correct interpretation should have been. This simply cannot be done.

Applicant recognizes that terms used in the claims are presumed to have their ordinary meaning. Applicant further notes that the specification, claims, figures, prosecution history, and any other intrinsic evidence can be used to interpret a claim to understand that meaning. Therefore, no attempt is made herein to analyze whether a term used in the claims is to have a meaning beyond that which is ordinary. Despite the Examiner's warning to the contrary, applicant reserves the right to interpret the terms used in the claims, both during and after prosecution, consistent with established case-law. Applicant further recognizes that the Examiner cannot remove the applicant's right to rely on established case-law concerning claim interpretation, including whether or not a claim term is to have its ordinary meaning or some other meaning, simply because the applicant has not explicitly indicated the claim term is to have a meaning other than an ordinary meaning.

E. Amendments to the Specification

The specification has been amended above to change the title of the invention. Applicant submits that the new title more closely describes the invention defined in the pending, non-withdrawn claims. Accordingly, applicant respectfully requests that the above amendment to the title be approved.

F. Rejection of the Claims based on the Cited References

Claims 1-6, 8-15, and 17-19 stand rejected under 35 U.S.C. § 102 as being anticipated by published PCT Appln. Pub. No. WO 99/13766 to Vrzalik et al. ("the '766 reference"). In addition, claims 7 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over the '766 reference in view of U.S. Patent No. 6,018,713 to Coli et al. ("the

'713 patent"). Finally, claims 8 and 17 also stand rejected under 35 U.S.C. § 103 as being unpatentable over the '766 reference in view of U.S. Patent No. 6,564,207 to Abdoh ("the '207 patent"). Applicant respectfully traverses this rejection for the reasons presented below.

Independent claims 1 and 11 recite a medical information management system and method that includes having a patient use a hand-held patient appliance that has an input/output device, a processor, and a memory. The patient uses the hand-held appliance in an interactive fashion based on patient tailored presentation that is generated by the processor based on data stored in the memory. The hand-held patient appliance communicates with an information management center via a first communication link.

A healthcare professional associated with that patient also interacts with the information management center via a healthcare professional terminal. However, the healthcare professional terminal provides a healthcare professional tailored presentation that is different from the patient tailored presentation. In addition, a third party (such as a family member) interacts with the information management center via a third party terminal. The third party terminal provides the user with a third-party tailored presentation that is different from the patient tailored presentation and different from the healthcare professional tailored presentation. Applicant submits that the cited references do not teach or suggest a medical information management system and method having these features.

The '766 reference teaches using a bed as a patient appliance, where the input/output device, processor, and memory are all connected to the bed. The claimed invention, on the other hand, defines the patient appliance as being a hand-held device. Clearly, a bed is not something that corresponds to a hand-held device. Furthermore, it would not be obvious to modify the teachings of the '766 reference to change the bed to hand-held device because eliminating the bed would render it inoperable for its intended purpose as a critical care system. If the proposed combination of references makes a prior art reference inoperable for its intended purpose, the resulting inoperable prior art reference may be considered to teach away from the proposed combination, i.e., not teach the combination, thereby supporting a showing of nonbviousness. *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). It is well settled that

obviousness cannot be established if the proposed modification to the reference renders it useless for its intended purpose. *Ex parte Westphalen*, 159 U.S.P.Q. 507, 508 (Bd. App. 1967); *see also*, *Ex parte Hartmann*, 186 U.S.P.Q. 366, 367 (Bd. App. 1974).

The Examiner correctly notes that the '766 reference teaches providing different levels of information to the various users of the system. See, page 18, lines 11-13, of the '766 reference. However, the '766 reference does not teach or suggest that the different levels of information be presented in a different manner for each type of user. As noted above, the present invention provides a patient tailored presentation, a healthcare professional tailored presentation, and a third-party tailored presentation each of which is different from the others so that each user is presented with information, both in terms of content and presentation format, that particularly suits that user. That is, the term "presentation" as used in the claims, means both the content and the format that the information is provided to the user. The '766 reference does not teach or suggest, for example, that the format for the information changes based on which type of user receives the information. At best, the '766 reference teaches that the content of the information changes. Furthermore, the other cited references do not teach or suggest modifying the format by which information is presented based on the type of user to whom the information is provided.

For the reasons presented above, applicant respectfully submits that independent claims 1 and 11 are not anticipated or rendered obvious by the cited references. In addition, claims 2-10 and 12-19 are also not anticipated or rendered obvious due to their dependency from independent claims 1 or 11, as well as on their own merits. For example, claim 3 recites limitations not found in the cited references, nor has the Examiner indicated where these features of claim 3 are taught or suggested. Accordingly, applicant respectfully request that the above rejection of claims 1-19 be withdrawn.

All objections and rejections have been addressed. It is respectfully submitted that the present application is in condition for allowance and a Notice to the effect is earnestly solicited.

Respectfully submitted,

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Attached: 1) Copy of October 4, 2001 Information Disclosure Statement and PTO-1449 Forms.